

Applicant: Arie Pieter Otte
Serial No.: 09/762,916
Filed: June 29, 2001
Page 7

REMARKS

Claims 25-38 and 43-49 were pending in the subject application. By this Amendment, claims 26, 27 and 43 have been canceled without prejudice or disclaimer, claims 25, 28-30, 35-37 and 44-46 have been amended, and new claims 56-63 have been added. Accordingly, upon entry of this Amendment, claims 25, 28-38, 44-49, and 56-63 as amended will be pending. Applicant has previously paid fees to cover the filing of six claims in excess of 20 claims.

Applicant maintains that the amendments to the claims do not raise an issue of new matter. Support for the amendments can be found at least as follows: amended Claims 25, 29, 30 - previous claims 26, 27 and 43, and Examples I-III on pages 6-12 of the application; amended Claim 28 - page 1, line 29; amended Claims 35-37 - in the previous version of the claims; amended Claims 44-45 - page 4, lines 20-23; amended Claim 46 - page 5, lines 4-6; new Claim 56 - page 10, line 28; new Claim 57 - page 9, lines 12-13; new Claim 58 - page 10, line 30; new Claims 59-62 - page 3, line 35 through page 4, line 13; new Claim 63 - page 8, line 36 through page 9, line 1. Accordingly, entry of the amendment is respectfully requested.

Election of Species Requirement

Applicant confirms the election of heterochromatin-binding protein 1 (HP1) as the species elected for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. MPEP §809.02(a). The elected species is the subject matter of Claim 59.

Applicant: Arie Pieter Otte
Serial No.: 09/762,916
Filed: June 29, 2001
Page 8

Applicant respectfully requests that the Examiner examine independent generic Claim 25 on its merits. Applicant is unaware of any prior art that would render Claim 25 unpatentable.

Claim 25 has been amended to clarify that the repressor protein comprises two parts, where the first part recognizes a DNA binding site for the repressor protein and the second part induces the formation of chromatin in which transcription is repressed. HP1 is one of the disclosed species that can make up the second part of the repressor protein. Other disclosed species, which like HP1 induce the formation of chromatin, are set forth in new dependent Claims 60-63. New Claims 60-63 do not read on the elected species. However, upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form. MPEP §809.02(a). Applicant is presenting Claims 60-63 at this time so that they can be considered by the Examiner once a generic claim is found allowable.

Dependent Claim 44 recites that the two part repressor protein can comprise a fusion protein, and dependent Claim 45 recites that the first part of the repressor protein binds the DNA binding site of LexA-DNA or GAL4-DNA. Applicant believes that the claim language has now been clarified such that it is clear that Claims 44 and 45 read on the elected species. Accordingly, applicant respectfully requests that the Examiner reconsider and examine Claims 44 and 45.

Applicant maintains that new Claims 56-58 read on the elected species.

Claim Objections

The claims have been amended to address the objections raised by the Examiner. Claim 27 has been canceled. Claim 25 has been amended to recite "host cells" in

Applicant: Arie Pieter Otte
Serial No.: 09/762,916
Filed: June 29, 2001
Page 9

place of “transcription system”.

Claim 37 has been amended to remove the abbreviation “FAGS”.

Claim 43 has been canceled, and Claim 25 has been amended to recite features of Claim 43.

Accordingly, reconsideration and withdrawal of the objections to the claims are respectfully requested.

Rejections Under 35 U.S.C. §112, First Paragraph

Claims 25-38, 43, and 46-49 are rejected under the written description requirement of 35 U.S.C. §112, first paragraph.

Applicant respectfully traverses this rejection.

Claim 25 has been amended to clarify that the repressor protein comprises two parts, where the first part recognizes a DNA binding site for the repressor protein and the second part induces the formation of chromatin in which transcription is repressed. The elected species HP1 is one of the disclosed species that can make up the second part of the repressor protein. Specific examples are provided in Examples I-III on pages 6-12 of the application. Applicant maintains that the specification describes the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention and that therefore the written description requirement is satisfied. MPEP §2163 (I). Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 25-38, 43, and 46-49 are rejected as indefinite under 35 U.S.C. §112,

Applicant: Arie Pieter Otte
Serial No.: 09/762,916
Filed: June 29, 2001
Page 10

second paragraph.

Applicant has amended the claims to clarify the claimed invention.

Claim 25 has been amended as follows. The phrase “cloning in a vector of DNA fragments between...” has been replaced with “cloning DNA fragments into vectors at a location between...” further to the Examiner’s recommendation. Step 2) has been amended to recite the term “host cells,” which provides an antecedent basis for “the host cells” in step 3). Step 3) has been amended to replace “the DNA sequence” with “a DNA sequence...” The term “which HP1 comprising complex” has been deleted.

Claim 37 has been amended to recite “fluorescent host cells” in place of “the fluorescent host cells...”

Claim 46 has been amended to no longer recite “the organism...”

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Correction of Attorney Docket Number

Please note that the Attorney Docket Number for this case has been changed to “27241/4.”

Applicant: Arie Pieter Otte
Serial No.: 09/762,916
Filed: June 29, 2001
Page 11

CONCLUSIONS

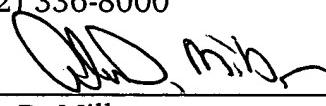
In view of the amendments and remarks made hereinabove, applicant respectfully requests that the Examiner reconsider and withdraw the objections and rejections set forth in the April 7, 2004 Office Action. In order to expedite prosecution of the subject application, applicant requests that the Examiner telephone the undersigned attorney if there are any minor matters preventing allowance of the subject application.

A check for \$210.00 is enclosed to cover the fee for a two month extension of time for a small entity. No other fee is deemed necessary in connection with the filing of this Amendment. However, if any other fee is required to preserve the pendency of the subject application, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 01-1785. Overpayments may also be credited fee to Deposit Account No. 01-1785.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN LLP
Attorneys for Applicant
90 Park Avenue
New York, New York 10016
(212) 336-8000

Dated: September 1, 2004
New York, New York

By 
Alan D. Miller
Reg. No. 42,889